

ESTTA Tracking number: **ESTTA544881**

Filing date: **06/25/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92057110
Party	Plaintiff Rin, Inc. Jeff Miller Max Kleven
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Date	06/25/2013
Attachments	13.06.24 Petitioners' Opposition.pdf(450732 bytes)

Jeff Miller, Max Kleven, and Rin, Inc.)	Petition for Cancellation No.: 92057110
)	
Petitioner,)	PETITIONER'S OPPOSITION TO
v.)	RESPONDENT'S MOTION TO DISMISS
)	PETITIONER'S PETITION FOR
Daphne Hereford,)	CANCELLATION
)	
Respondent.)	Mark: RIN TIN TIN
)	
)	Registration Nos.: 3111161, 2969852, 3582436, 2538312, and 1763135
)	
)	Mark: RIN TIN TIN CANINE AMBASSADOR CLUB
)	
)	Registration No.: 2384745

This instant Motion to Dismiss filed, through counsel, on June 4, 2013 by Respondents Daphne Hereford (“Hereford”) and her corporation Rin Tin Tin, Inc. (“RTT, Inc.”) (together “Respondents”) comprises fourteen bullet-point style paragraphs asserting arguments as to why Petitioners’ instant Petition for Cancellation should be dismissed. Petitioners assert that each of these arguments is flawed, either procedurally or legally. Petitioners will address each argument individually below and respectfully request that the Board deny Respondents’ instant Motion to Dismiss.

In Paragraph one, Respondents assert that the instant Petition for Cancellation should be dismissed because federal trademark registration nos.: 3111161, 2969852, 2538312, and 176135 for the mark RIN TIN TIN and federal trademark registration no.: 2384745 for the mark RIN TIN TIN CANINE AMBASSADOR CLUB are incontestable and, therefore, cannot be cancelled. This statement reflects an incorrect understanding of trademark law. Petitioners'

instant Petition for Cancellation pleads that the above mentioned federal trademark registrations misrepresent the source of the associated goods and services, were procured through fraud, and suggest a false connection. Pursuant to 15 U.S.C. §1064(3) and 15 U.S.C. § 1052(a) these particular causes of action may be brought at any time. As such, Respondents' argument is based on an incorrect understanding of trademark law and Respondents' request for dismissal based on such argument should be denied.

II. Respondents' Argument Contained in Paragraph 2 is Irrelevant and Comprises an Incorrect Understanding of the Law and, Therefore, should be Denied.

In Paragraph two, Respondent points out that the named Petitioners/Plaintiffs in the concurrently filed Petition for Cancellation no: 92056642 and the Federal Civil Action filed in the Central District of California, case no.: CV-13-02783-ABC, are not identical. Respondents characterize this observation as an "*inconsistent and contradictory pleading*" and encourage the Board to dismiss Petitioners' instant Petition for Cancellation for this reason.

However, there is no requirement that all Petitioners that have standing join any particular action. With respect to a Petition for Cancellation, any person who believes he, she, or it is or will be damaged by a registration of a mark has standing to file a complaint. Trademark Act §13, Trademark Act § 14, 15 U.S.C. §1063, and 15 U.S.C. §1064. At the pleading stage, all that is required is that a plaintiff allege facts sufficient to show a "real interest" in the proceeding, and a "reasonable basis" for its belief that it would suffer some kind of damage if the mark is registered. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). *See also Herbko International Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1377 (Fed. Cir. 2002); *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2024 (Fed. Cir. 1987) *on remand*, 5 USPQ2d 1622 (TTAB 1987), *rev'd*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988) (trade association has standing to maintain opposition); *See also*, TBMP § 303.06 regarding pleading of standing by joint plaintiffs. To plead a "real interest," plaintiff must allege a "direct and personal stake" in the outcome of the proceeding. *Corporacion Habanos S.A. v. Annas Inc.*, 88 USPQ2d 1785 (TTAB 2008) (Cuban entity has standing although it does not and cannot engage in any business in the United States due to the embargo on Cuban goods). The allegations in support of plaintiff's belief of damage must have a reasonable basis "in fact." *Ritchie v. Simpson*, 170 F.3d 1092, 50

USPQ2d 1023, 1027 (Fed. Cir. 1999) (stating that the belief of damage alleged by plaintiff must be more than a subjective belief).

In the instant Petition for Cancellation, all Petitioners have pleaded an ownership interest in multiple copyrighted works that feature the iconic fiction German Shepherd named Rin Tin Tin and common law rights in the RIN TIN TIN mark. As such, all Petitioners have met the threshold requirement of standing and Respondents' request for dismissal based on the argument contained in paragraph three should be denied.

III. Respondents' Argument Contained in Paragraph 3 Reflects Respondents' Counsel's Lack of Understanding of Civil Procedure and, Therefore, Should be Denied.

Respondents' counsel quotes Petitioners' counsel's language from Petitioners' Opposition in the concurrently filed and related Petition for Cancellation no: 92056642 wherein Petitioner's counsel wrote, "*this allegation is based on facts that are very much in dispute, this issue is not ripe for adjudication at this time.*" Respondents' counsel is presumably presenting this argument in support of the instant Motion to Dismiss. This reflects a misunderstanding of civil procedure.

If a Motion to Dismiss presents matters outside the pleadings and such evidence is considered by the Court, "the motion must be treated as one for Summary Judgment under Rule 56." Fed R. Civ. Proc. 12(d). In that event, the standard changes from determining whether a claim for relief has been *stated* (Rule 12(b)(6)) to determining whether there is a "*genuine dispute as to any material fact* and the movant is entitled to judgment as a matter of law" (FRCP 56(a) (emphasis added)). [*Global Network Communications, Inc. v. City of New York* (2nd Cir. 2006) 458 F3d 150, 154–155; *Hamilton Materials, Inc. v. Dow Chem. Corp.* (9th Cir. 2007) 494 F3d 1203, 1207].

Here, as will be addressed next, Respondents ask the Board to consider the language of a past settlement agreement. The settlement agreement is outside of the pleading of this instant Petition for Cancellation; therefore, should the Board to choose to consider the past settlement agreement this Motion to Dismiss will be converted to a Motion for Summary Judgment governed by Federal Rule Civil Procedure 56 and the corresponding threshold question will change from whether a claim for relief has been stated to whether there exists *no genuine dispute as to any material fact*. If a genuine dispute as to any material fact exists, then the dispute is not ripe for adjudication at this time and Respondents' Motion to Dismiss should be denied. As will

be discussed next, Petitioners' assert that the settlement agreement *is replete with genuine issues of material fact in dispute*; therefore, this Motion is not ripe for adjudication and should be denied at this time. Respondents' assertion of the language to support any other conclusion reflects a lack of understanding of the threshold question.

IV. Respondents' Arguments Contained in Paragraphs 4 through 10 Address Evidence Outside the Pleadings that is Replete with Genuine Issues of Material Facts in Dispute.

In paragraphs 4 through 10 of Respondents' Motion to Dismiss, Respondents direct the Board's attention to a past settlement agreement between the parties and to particular clauses within the settlement agreement that Respondents interpret to be favorable to their position. Respondents further request that the Board adopt their interpretation of this contract and dismiss the instant Petition for Cancellation. Petitioners assert that the interpretation of almost every clause in the settlement agreement and the validity of the entire settlement agreement is in dispute.

For example, Petitioners believe that Respondents fundamentally breached and repudiated the agreement when Respondent Daphne Hereford pursued a registration for the mark RIN TIN TIN in international class 041 after having agreed to assign her registration for class 041 to Max Kleven in the settlement agreement.

Pursuant to Federal Rule of Civil Procedure 60(b)(6), the a court may be permitted to relieve a party "from a final judgment, order, or proceeding for ... any ... reason justifying relief from the operation of the judgment." Generally, only "extraordinary circumstances" justify relief under the rule. *United States v. Sparks*, 685 F.2d 1128, 1129 (9th Cir.1982). Repudiation of a settlement agreement that terminated litigation pending before a court constitutes an extraordinary circumstance, and it justifies vacating the court's prior dismissal order. *United States v. Baus*, 834 F.2d 1114, 1124 (1st Cir.1987); *Fairfax Countywide Citizens v. Fairfax County*, 571 F.2d 1299, 1302-03 (4th Cir.), *cert. denied*, 439 U.S. 1047, 99 S.Ct. 722, 58 L.Ed.2d 706 (1978); *Aro Corp. v. Allied Witan Co.*, 531 F.2d 1368, 1371 (6th Cir.), *cert. denied*, 429 U.S. 862, 97 S.Ct. 165, 50 L.Ed.2d 140 (1976); *VanLeeuwen v. Farm Credit Admin.*, 600 F.Supp. 1161, 1164, 1167 (D.Or.1984).

Further, Petitioners believe that by attempting to reclaim the very trademark that was assigned pursuant to the settlement agreement that Respondents caused the consideration for the settlement agreement to fail in a material respect, thereby allowing for rescission. Pursuant to

California Civil Code, § 1689, subd. (b)(4) a party may rescind a contract "[i]f the consideration for the obligation of the rescinding party, before it is rendered to him, fails in a material respect from any cause." *Associated Lathing and Plastering Co. v. Louis C. Dunn, Inc.*, 135 Cal.App.2d 40 (1955); *Pennel v. Pond Union School Dist.*, 29 Cal.App.3d 832 (1973); *Crowley v. City and County of San Francisco*, 64 Cal.App.3d 450 (1976); *Wylar v. Feuer*, 85 Cal.App.3d 392, 404 (1978) ("A failure of consideration by one party is material only if it goes 'to the `essence' of the contract.") *Karz v. Department of P. & V. Standards*, 11 Cal.App.2d 554, 557 (1936) ("[A] person is entitled to rescind or abandon a contract for an alleged breach of that contract when the breach goes to the root of the consideration.")

These are just a few examples of the many genuine disputes as to the material facts regarding to the validity of the settlement agreement and the interpretation of its various clauses. As stated above, if the Board chooses to consider the settlement agreement, the instant Motion to Dismiss is governed by Federal Rule of Civil Procedure 56 and this Petition for Cancellation will not be ripe for adjudication at this time.

V. Respondents' Paragraph 11 Comprises a Mere Conclusory Statement Unsupported by any Fact or Argument

In paragraph 11 of Respondents' Motion to Dismiss, Respondents merely state that Petitioners' petition for Cancellation "*fails to state a claim upon which relief may be granted.*" This is the proper threshold question for a Motion to Dismiss pursuant to Fed. R. Civ. P. 12(b) but it is unsupported by any fact or argument. As such, Respondents' request for dismissal based merely on stating the threshold question for dismissal without any further supporting facts or arguments must fail.

VI. Respondents' Paragraphs 12 and 13 Comprise Mere Conclusory Statements Unsupported by Facts or Argument, Further, such Conclusory Statements relate to Equitable Defenses and are Not Relevant to a Motion to Dismiss.

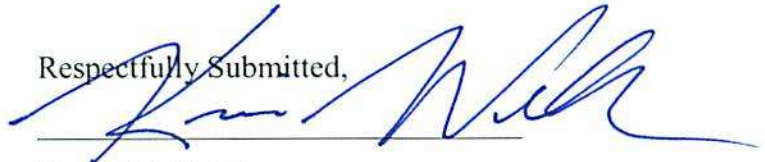
In paragraphs 12 and 13 of Respondents' Motion to Dismiss, Respondents offer bare conclusory statements asserting various equitable defenses. These statements are unsupported by any facts or argument and, more importantly, are not grounds for summary dismissal of a Petition for Cancellation. As such, Respondents' request for dismissal of the instant Petition for Cancellation based on the language of paragraphs 12 and 13 must fail.

VII. Conclusion

For the reasons set forth above, Petitioners respectfully request that the Board deny Respondents' instant Motion to Dismiss and allow this matter to proceed to Discovery.

Date: June 24, 2013

Respectfully Submitted,

A handwritten signature in blue ink, appearing to read 'Kevin M. Welch', is written over a horizontal line.

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the forgoing PETITIONERS' OPPOSITION TO RESPONDENTS' MOTION TO DISMISS PETITIONERS' PETITION FOR CANCELLATION has been served upon Daphne Hereford, *pro se* Defendant and board member of Rin Tin Tin, Inc., via U.S. Mail, on June 24, 2013 at the following address:

Daphne Hereford
Post Office Box 27
Crockett, TX 75835

Dated: June 24, 2013

By: _____



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